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02 OCT 2006

In re Application of
Grant et al.

Application No.: 10/538,160

PCT No.: PCT/US03/38899

Int. Filing Date: 08 December 2003

Priority Date: 08 December 2002

Attorney Docket No.:IMMR-0152A (034701-000510)

For: Methods And Systems For Providing Haptic :
Messaging To Handheld Communication Devices :

DECISION

This is in response to the "Petition To Correct Inventorship Under 37 CFR 1.497" filed on 27 June 2006, which is being treated under 37 CFR 1.497(d).

BACKGROUND

This international application was filed on 08 December 2003, claimed an earlier priority date of 08 December 2002, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 08 June 2005. Applicant filed *inter alia* the basic national fee on 08 June 2005.

On 23 February 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant, requiring the submission of an executed oath or declaration and a surcharge under 37 CFR 1.492(h).

DISCUSSION

The declaration of the inventors filed on 27 June 2006 nominates two inventors, Erik J. Shahoian and Dean C. Chang, who were not nominated in the published international application, nor is an appropriate Form PCT/IB/306 present in the application file. Counsel requests treatment under 37 CFR 1.497. A declaration filed under 37 CFR 1.497 (d) must be by the actual inventor or inventors as required under 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47. The declaration must be accompanied by (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part, (2) the processing fee set forth in 37 CFR 1.17; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (*See* 37 CFR 3.73(b)). *See* Section 201.03 of the Manual of Patent Examining Procedure (M.P.E.P.).

Regarding requirement (1), applicants have provided an appropriate statement by each of Erik J. Shahoian and Dean C. Chang.

Regarding requirement (2), the required processing fee has been paid.

Regarding requirement (3), the "Consent of Assignee" document included among the instant correspondence is signed on behalf of Immersion Corporation by Laura Peter in the capacity of "Vice President and General Counsel," and who further states that she is "authorized to execute this Consent of

Assignee." The "Consent of Assignee" is accompanied by a "Statement Under 37 CFR 3.73(b)," also signed by Ms. Peter, which asserts that Immersion Corporation is "the assignee of the entire right, title and interest" in this application. The "Statement..." references attached "copies of assignments or other documents in the chain of title." A copy of an assignment document has provided; however, the assignment is accompanied by neither an instruction to record the assignment nor by a statement specifying where documentary evidence of a chain of title is recorded in the assignment records of the USPTO (e.g., reel and frame number). As such, applicants have failed to comply with 37 CFR 3.73(b). Therefore, requirement (3) has not been satisfied.

Inspection of the declaration filed on 27 June 2006 reveals that it appears to have been assembled by aggregating individual sheets signed by each of the inventors into a single document. Since counsel has not provided copies of the complete declaration documents signed by each inventor, it is not clear that each inventor had the benefit of signing a complete copy of the declaration document. Moreover, the declaration includes an uninitialed alteration to Mr. Shahoian's name. Therefore, it would not be appropriate to grant the requested relief at this time.

CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT** of this application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.497(d)". No additional processing fee is required.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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